

Appl. No. 10/087,856  
Amdt dated Dec. 11, 2003  
Reply to Office Action of Jul. 11, 2003

### **Remarks**

Claims 1-20 are in this application and with this amendment claims 1, 3-8, 10-20 remain. Claims 2 and 9 are cancelled and claims 1, 3-8, 10-14 and 19-20 are amended.

Applicants note with thanks the examiner's acknowledgment that claims 15-18 are directed to allowable subject matter.

### *Claim Objections*

Claims 1-13 are objected to on the basis that the subject matter thereof relates more appropriately to a system than a device as claimed. Applicant amends claims 1, 3-8 and 10-13 to relate to a system as suggested by the examiner.

Claims 3 and 4 are objected to on the basis that they are indefinite. Applicant amends claim 3 and 4 to recite electrical current as the only energy such that claims 3 and 4 are definite.

Claim 14 is objected to for being indefinite. The Examiner alleges that the reference to inner and outer ends is ambiguous, suggesting references to both surfaces and ends. Though applicant does not necessarily agree there is ambiguity or lack of clarity, to enhance clarity an amendment to refer to distal and proximal ends is made. Claim 14 is voluntarily amended to depend from claim 1.

### *Claim Rejections*

Claims 1, 2, 5, 6, 9, 10 and 13 are rejected under 35 U.S.C. 102 as being anticipated by Fletcher et al. (US 5,591,162). In particular, the Examiner alleges that, regarding claim 1, Fletcher et al. disclose a system comprising a first and second elongate probe

Appl. No. 10/087,856  
Amdt dated Dec. 11, 2003  
Reply to Office Action of Jul. 11, 2003

wherein the distal portion of each probe comprises energy delivery means. Applicant amends claim 1 to specify that the energy delivery means "concentrate[s] delivery of" energy between the treatment sites and that "at least one probe includes a cooling means for controlling the temperature of tissue adjacent the energy delivery means of the at least one probe in association with the delivery of energy." That the probes are complementary to concentrate energy between themselves and that cooling means are available are features which are neither disclosed or suggested by Fletcher et al. Claim 1 is voluntarily amended to specify that "the energy delivery means is configured to provide a form of energy selected from a group consisting of: electrical; microwave; and ultrasound energy".

Similar subject matter relating to cooling means now inserted into claim 1 was recited in original claim 9. The examiner alleged with reference to claim 9 that Fletcher et al. disclose a cooling means at col. 4, line 3 to col. 5, line 4. Applicant respectfully disagrees with the examiner's conclusion. As the examiner notes, Fletcher et al. disclose a system with first and second probes wherein the distal portion of each probe comprises energy delivery means and the form or energy is thermal or cryogenic energy. Fletcher et al. do not show a probe that includes both an energy delivery means for delivering thermal energy to heat tissue and a cooling means for cooling the tissue during the heating process. Thus, claim 1 is allowable over Fletcher et al.

Amended claims 3 and 4 are believed allowable over Fletcher as they relate to electrical current energy not disclosed by Fletcher.

Regarding claims 5 and 6, Applicants amend these claims to recite that the energy delivery means and the cooling means operate to provide certain results. Such is not shown by Fletcher et al.

Appl. No. 10/087,856  
Amdt dated Dec. 11, 2003  
Reply to Office Action of Jul. 11, 2003

Regarding claim 10, it is rejected in view of a feature allegedly shown by Fletcher et al. Applicants submit claim 10 is allowable at least for the reason that it depends from allowable claim 1. Applicant's note a small amendment to claim 10 is included not to address the examiner's rejection but to better capture Applicants' invention. A similar amendment is made to claim 11.

Claim 13 is amended to specify that the distal portion has a shape for directing the delivery of energy between the probes to concentrate the energy in accordance with the disclosed invention. Claim 13 depends from amended claim 1 and is believed allowable for this reason.

Claims 1-7, 10, 12-14, 19 and 20 are rejected under 35 U.S.C. 102(b) as anticipated by Eggers et al. First, applicant notes that Eggers et al. is not alleged to anticipate original claim 9. The subject matter thereof is substantially inserted into amended independent claims 1, 19 and 20. Applicants believe that claims 1-8, 10-13 and 19-20 are thus allowable.

Moreover, Applicants note that claim 14 is amended to depend from claim 1. As such it is allowable for at least this reason.

Applicants have amended claims 12 and 14 in accordance with the disclosed invention.

The examiner alleges that, with respect to claim 20, Eggers et al. show a system comprising an electrical impedance meter (measurement means) communicating between the distal portions of each probe. Applicant traverses the rejection and notes that claim 20 has and still recites "an energy delivery means for delivering energy to the annulus fibrosus wherein the energy delivery means is configured to selectively deliver

Appl. No. 10/087,856  
Amdt dated Dec. 11, 2003  
Reply to Office Action of Jul. 11, 2003

the energy in a desired direction". Such an energy delivery means is not disclosed by Eggers et al.

In view of the foregoing, Applicants respectfully requests that a timely Notice of Allowance be issued in this case.

If the Examiner believes there are any further matters which need to be discussed in order to expedite the prosecution of the present application, the Examiner is invited to contact the undersigned.

Respectfully submitted,



Jonathan POLLACK  
Registration No. 34963

Telephone 416-340-6192  
Facsimile 416-977-5239  
[jpollack@ogilvyrenault.com](mailto:jpollack@ogilvyrenault.com)  
Suite 1100, P.O. Box 11  
200 King Street West  
Toronto, Ontario  
Canada M5H 3T4

Date: Dec. 11, 2003